

REMARKS

This Amendment is submitted in response to the Office Action dated 06 August 2004 and is accompanied by a Petition for Two-Month Extension of time to extend the due date to 06 January 2005. Claims 1-8, 10-13, 15-18, and 20-21 are pending after entry of this amendment. Claims 20-21 have been added. Reconsideration of all pending claims with an eye toward allowance is respectfully requested.

Applicant has amended the Abstract to correct the identified informalities. These corrections are indicated on page 3 of this paper as well as on a clean version of the Abstract provided on a separate sheet following the Remarks section of this paper.

Applicant acknowledges that Claim 14 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has incorporated the limitations of Claim 14 into Claim 1 and submits that Claim 1 and claims dependent therefrom are patentable over the cited prior art.

Applicant also acknowledges that Claims 13, 15, and 16 would be allowable if rewritten to overcome the rejection(s) under 35 USC 112, second paragraph, set forth in the office action.

Finally, Applicant acknowledges that Claims 6-8, 10-12, 17, and 18 would be allowable if rewritten or amended to overcome the rejections under 35 USC 112, second paragraph, as set forth in the office action.

Therefore only Claims 1-5, 9, and 19 are rejected over cited prior art. Claims 2-5 depend from Claim 1, Claim 9 depends from Claim 6, and Claim 19 depends from Claim 17 via intervening Claim 18.

Claims 1-5, 13, and 14 were objected to because the third occurrence of "a" on Claim 1 line 10 should have been --the--. Claim 1 has been amended to correct this error and Applicant trusts that the objection to these claims will be withdrawn.

Claims 6-13, and 15-19 were rejected under 35 USC 112, second paragraph, as being indefinite either because certain phrases appeared to lack proper antecedent

basis or because certain phrases in the claims appeared to be vague, indefinite, or awkwardly or confusingly worded. Applicant has amended the claims to provide proper antecedent basis were necessary and to attempt to clarify possibly awkward or confusing wording.

With particular reference to possibly vague, indefinite, or awkwardly and/or confusingly worded claims, Applicant offers several remarks. First, the “pad conditioning force” is a force applied to the retaining ring and the front surface of the retaining ring in turn is pressed against the polishing pad surface (See for example, page 7, lines 1-3 of the specification as filed.) The force applied to the retaining ring acts to modify the profile of the polishing pad, or to condition the pad, so that it interacts in the intended fashion with the retaining ring and with the semiconductor wafer or other substrate. Applicant believes this language is clear and unambiguous, however, Applicant is willing to consider variations of this language in order to advance prosecution to allowance.

With reference to the examiner’s suggestion that the phrase “and to decrease the orthogonal component to expand of the region over which said pad is flat” is unclear, Applicant has amended this phrase to recite --and to decrease the orthogonal component in the region over which said pad is flat-- and trusts that the rejection of Claims 13, 15, and 17 will be withdrawn.

With reference to the suggestion that the phrase “applying ... force” in Claim 17 at lines 14-17, Applicant is uncertain as to which aspect of the phrase is unclear or indefinite. Applicant has addressed the meaning of “pad conditioning force” with reference to Claims 13 and 15. Applicant has also amended the claim to clarify other possibly unclear elements of the claim. Applicant also notes that when the retaining ring contacts the polishing pad area immediately after the passage of the wafer or other substrate, the pad surface does not immediately rebound (vertically) at the edge of the wafer but instead at the edge of the retaining ring and the shape of the retaining ring provides a transition in the components of force applied orthogonally and non-orthogonally to the polishing pad surface as the retaining ring presses on and rotates on the surface of the pad. (See for example, page 7, lines 5-10 of the specification.)

Applicant trusts that with these amendments and explanation, the rejection to Claim 17 will be withdrawn.

Claims 1, and 3-5 have been rejected under 35 USC 102(e) as being anticipated by Mack (US 5941758), and under 35 USC 102(b) as being anticipated by Henderson (US 5679069). Claim 1 is an independent claim and Claims 3-5 are dependent therefrom. Without admitting the propriety of the rejection, applicant notes that the limitation of allowable Claim 14 has been added to Claim 1 placing Claim 1 and all claims dependent therefrom (e.g. Claims 2-5, and 13) in condition for allowance. Applicant reserves the right to pursue a version of Claim 1 prior to amendment in a related continuing application.

Claims 9 and 19 have been rejected under 35 USC 102(e) as being anticipated by, or in the alternative, under 35 USC 103(a) as obvious over either Mack or Henderson. Without admitting the propriety of the rejection applicant has cancelled Claims 9 and 19 without prejudice to present and prosecute in a related application.

Claim 2 has been rejected under 35 USC 103(a) as being unpatentable over Henderson in view of Drill et al (6139428). As Claim 2 is dependent from now allowable Claim 1, Claim 2 is now in condition for allowance. Applicant does not admit the propriety of the rejection to Claim 2 and reserves the right to present and prosecute a claim corresponding to Claim 2 or to Claim 2 in combination with Claim 1 in a related application.

Applicant has added Claim 20 which is analogous to Claim 1 as amended and substitutes a "substrate" for the "semiconductor wafer" of Claim 1, and "processing" in the preamble for "polishing" of Claim 1. There is support in the specification for a more generalized processing and substrates as well as support in Claim 6. Claim 21 requires that the substrate is a substrate selected from the set of substrates consisting of a semiconductor wafer substrate and a glass substrate, each of which are set forth in the specification.

With these amendments and remarks Applicant submits that all pending claims are in condition for allowance and requests allowance of same.

Based on the foregoing, Applicant respectfully submits that the application is now in condition for allowance. If any matters can be resolved by telephone, the Examiner is invited to call the undersigned attorney at the telephone number listed below. The Commissioner is authorized to charge any additional fees, including but not limited to fees for additional claims not already paid for or for extensions of time petitions, to Deposit Account No. 50-2319 (Order No. A-67520-5/RMA (475852-10)).

Dated: January 6, 2005

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Respectfully submitted,

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A handwritten signature in cursive script, reading "R. Michael Ananian", written in black ink over a horizontal line.

R. Michael Ananian, Reg. No. 35,050

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